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PC26876**REMARKS**

Claims 20-22 have been cancelled.

Applicant reserves the right to file any continuation thereon.

Upon reviewing the claims to respond to the July 19, 2004 Office Action, a typographical omission was discovered. Substituent R³ was omitted from formula I of claim 1. Substituent R³ has been added to formula I of claim 1. Support for this amendment can be found on at least page 3, line 24 of the Specification as filed. Furthermore, substituent R³ is in the definition of claim 1 as originally filed but was not in formula I.

35 USC 112, first paragraph:

Claims 1-6, 9, 10, and 13-26 were rejected for containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record and stated therein. The rejection concerned prodrugs of formula I.

The term "prodrugs" has been stricken from claim 1. Applicants reserve the right to file any subsequent application thereon. Applicants request reconsideration and withdrawal of this rejection.

35 USC 112, second paragraph:

Claims 13-26 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record and stated therein.

Claim 13 has been amended to list specific diseases and disorders to be claimed. Support for this amendment is found on at least page 2, lines 23-30; and page 6, lines 4-31. Applicants reserve the right to file any subsequent application thereon. Applicants request reconsideration and withdrawal of this rejection.

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PC26876**Double Patenting Rejection:**

Examiner has withdrawn the obviousness-type double patenting rejection of paragraph 5 in the June 10, 2003 Office Action, but has not indicated whether the provisional obviousness-type double patenting rejection regarding copending application 10/013,858 discussed in paragraph 6 of the June 10, 2003 office action is withdrawn. Applicants incorporate the arguments made in the response submitted by transmittal dated 9/10/2003 and request reconsideration and withdrawal of said provisional double patenting rejection.

New Grounds of Rejection:

New grounds were raised in the July 19, 2004 Office Action for rejection of the specification and claims. The Office Action references amendments dated September 15, 2003. The Amendments were filed by transmittal and proof of service dated September 10, 2003. The post-card receipt indicates that the communication was received by the USPTO on September 15, 2003. However, they were "filed" on September 10, 2003. See 37 CFR 1.8.

Furthermore, Applicants take exception with the new rejections raised. The amendments filed on September 10, 2003 concerned clerical/typographical errors. The rejections raised herein concern material that existed in the patent application as originally filed.

(a) Specification:

The amendment to the specification in the amendment mailed/filed on September 10, 2003 was not entered because no direction was provided regarding how so amend. Said direction is herein provided with the attached amendments. Examiner is requested to reconsider and withdraw said rejection and to accept the amendment to the Specification as herein provided.

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PC26876(b) Incorporation of Material:

The term "incorporated by reference" has been rejected to, stating that incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper.

The rejected phrase occurs in two locations in the Specification as originally filed: page 8, line 23 and page 34, line 8. The paragraphs containing these rejected phrases have been amended.

The phrase on page 8 has been stricken. Examiner is requested to reconsider and withdraw said rejection.

The paragraph starting on page 34 with the rejected phrase has been amended to incorporate the appropriate material. The declaration signed by the attorney representing the applicant is also provided. The paragraph has been amended to include now the issued patent number of the referenced patent application. The material incorporated is from column 3, line 44 to column 4, line 59, excluding the "aa" typographical inclusion. Within the text added, "- ϕ refers to phenyl (C_6H_5)." has been inserted at the end of the paragraph that ends in column 4, line 44 to define - ϕ , which is defined at column 7, line 52 of US 6,468,999. Charts A-C which have been incorporated are found in column 22, line 1 to column 24, line 15. Examiner is requested to reconsider and withdraw said rejection.

(c) 35 USC §112, second paragraph:

Claims 7 and 20 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7:

Many rejections were raised for claim 7, claiming that there is insufficient antecedent basis for the specified limitation in the specific rejection. Applicants traverse. In this response, reference will be made to the compounds in the amendment for ease of reference; however, the aspects to which the current rejections pertain were in claim 7 as originally filed.

"A claim is indefinite when it contains words or phrases whose meaning is unclear. . . . Obviously, however, the failure to provide explicit antecedent basis for

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terms does not always render a claim indefinite. If the scope of the claim would be reasonably ascertained by those skilled in the art, then the claim is not indefinite." MPEP 2173.05(e), citation omitted. Claim 7 is an independent claim concerning compounds as they are recited in the specification. The claims are clear and not indefinite as written. Support for claim 7 is found in the specification as originally filed as here provided:

September 10, 2003 Amendment, page 7, line 14 to page 8, line 4 finds support in the Specification as originally filed on page 11, lines 6-29. This concerns rejection 8(a) to (d).

September 10, 2003 Amendment, page 8, lines 6-17 finds support in the Specification as originally filed on page 11, line 31 to page 12, line 10. This concerns rejection 8(e) to (f).

September 10, 2003 Amendment, page 10, line 18 to page 11, line 21 finds support in the Specification as originally filed on page 14, line 10 to page 15, line 13. This concerns rejection 8(g) to (l).

September 10, 2003 Amendment, page 13, line 20 to page 14, line 23 finds support in the Specification as originally filed on page 17, line 10 to page 18, line 13. This concerns rejection 8(m) to (r).

September 10, 2003 Amendment, page 16, line 23 to page 17, line 27 finds support in the Specification as originally filed on page 20, line 14 to page 21, line 17. This concerns rejection 8(s) to (x). Please note that (t) referenced page 17, lines 7-8 of the September 10, 2003 amendment, but the reference should have been to lines 9-10. Please further note that (u) referenced page 17, lines 9-10 of the 9/10/2003 amendment, but the reference should have been to lines 11-12.

September 10, 2003 Amendment, page 19, line 25 to page 20, line 29 finds support in the Specification as originally filed on page 23, line 16 to page 24, line 19. This concerns rejection 8(y) to (ad).

9/10/2003 Amendment, page 22, line 29 to page 23, line 33 finds support in the Specification as originally filed on page 26, line 20 to page 27, line 22. This concerns rejection 8(ae) to (aj).

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September 10, 2003 Amendment, page 25, line 31 to page 27, line 2 finds support in the Specification as originally filed on page 29, line 20 to page 30, line 23. This concerns rejection 8(ak) to (ap).

September 10, 2003 Amendment, page 29, line 2 to page 30, line 6 finds support in the Specification as originally filed on page 32, line 23 to page 33, line 27. This concerns rejection 8(aq) to (av).

Examiner is requested to reconsider and withdraw said rejection with regard to claim 7.

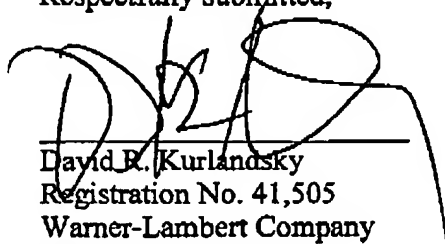
Claim 20:

Claim 20 has been deleted. Examiner is requested to reconsider and withdraw said rejection with regard to claim 20.

In view of the present amendment and foregoing remarks, reconsideration of the rejection and advance of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with the communication to our deposit account number 23-0455.

Respectfully submitted,

Dated: 10/19/04
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